

Claims 1-20 are pending in this application.

Applicant's election with traverse of Example I, a mixture of Compound of formula I and cyprodinil, in the reply filed on 1/22/2010 is noted again. New claim 20 fails to read on the elected cyprodinil, and therefore claim 20 is withdrawn from further consideration as being directed to non-elected subject matter.

Claims 1-19 will presently be examined to the extent that they read on the elected subject matter of record.

Applicant's disqualification of WO 2004/016088 under 35 USC 103(c) is deemed proper.

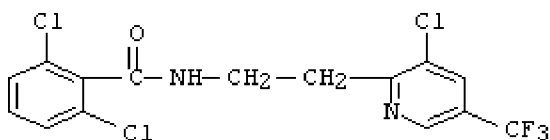
A misspelling of cyprodinil is noted in claim 10.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of WO 01/11965 and Hubele (US 5,153,200) in view of HCAPLUS abstract 1995:694232 and Hopkinson (US 6,746,988).

WO 01/11965 broadly discloses applicant's compounds of formula (I) as fungicides. See Example 5 in paragraph 0096 in view of paragraphs 0002 to 0031. The structure of Example 5 compound is drawn below by the undersigned Examiner.



It is noted that this compound is readable on applicant's independent claim 1, formula (I), and all other dependent claims except dependent claims 8 and 9. Alternative substitution on the phenyl ring moiety is disclosed as including halogen and haloalkyl (C₁₋₆). See paragraphs 26 and 28. Fungicidal activity against fungal diseases of plants such as mildews, cereal powdery mildew, *Erysiphe graminis* and many others are disclosed (paragraph 0037). Combination with other fungicides, insecticides and pesticides is disclosed (paragraph 0041). Concentration of 0.0001 to 1 wt% for direct application and 5 to 95 wt% concentrate strength composition are disclosed (paragraph 0052). 5-1000 g per hectare application rate is disclosed (paragraph 0053). Combination with diluent, carrier, and various additives such as surface active agent dispersing agent, emulsifying agent is disclosed (paragraphs 0042-0051). See treatment is disclosed (paragraph 0053). Soil application and foliar application are disclosed (paragraphs 0053-0054).

Hubele discloses cyprodinil as a well-tolerated fungicide to curatively or preventively protect crops of useful plants (paragraph bridging columns 1-2; column 3, last two lines; column 12, lines 26-39; column 16, Example 1.1). See columns 12-15 for specific disclosures on activity, application, formulation and crops to be protected: 50g

to 5 kg/hectare application rate; 0.1-95 wt% concentration range; formulations with various carriers and surfactants; seed treatment. Activity against various fungal pathogens is disclosed (columns 90-92). Insecticidal activity as well as fungicidal activity is disclosed (column 12, lines 26-30, 53-55). Combinations with other active agents such as other fungicides are disclosed (column 13, first full paragraph).

HCAPLUS abstract 1995:694232 discloses CGA 219417, an earlier name for cyprodinil, as a broad-spectrum fungicide for protection of various crops against many different fungi. Inhibition of methionine mode of action is disclosed, as well as its safety. Flexible use in integrated disease control practices is disclosed.

The patent by Hopkinson et al. is cited to establish that applicant's compound (b) and (c) fungicides are well-known fungicides, which are known to be used in combination. See claim 16, which discloses for example cyprodinil, trifloxystrobin, propineb, tolyfluanid, iprodione and many other well-known fungicides, and mixtures thereof.

The difference between the claimed invention and the cited references is that the references do not expressly disclose the specific combination of compound I + cyprodinil. However, both compounds have been taught by the prior art as agriculturally useful fungicides, and combination with other fungicides has been specifically suggested. Therefore, one having ordinary skill in the art would have been motivated to combine the fungicidal compound of formula I such as compound I with a well-known fungicide such as cyprodinil with the expectation of obtaining an advantageous

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fungicidal mixture, as claimed. In re Kerkhoven, 205 USPQ 1069, 1072 (CCPA 1980); In re Crockett, 126 USPQ 186 (CCPA); Ex parte The NutraSweet Co., 19 USPQ2d 1586, 1587 (Bd. Pat. App. & Int. 1991). Further addition of a third known fungicide such as propineb would have been similarly suggested from the motivation to obtain additional activity and spectrum of control.

Regarding the claimed ratio of 0.01 to 20 (a to b), such ratio would have been obvious from the prior art concentration and application amounts, which when combined at their known amounts and rates would provide such ratio of components.

Applicant's specification data has been reviewed, but the data there is not commensurate in scope with that of the claims. Evidence of nonobviousness, if any, must be commensurate in scope with that of the claimed subject matter. In re Kulling, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); In re Lindner, 173 USPQ 356, 358 (CCPA 1972).

Specific notes pertaining to applicant's data

(1) Data for Example 1, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide + cyprodinil is noted, but there is no other evidence that similar result would be obtained with other compounds of formula (I) + cyprodinil. Further explanation or evidence is required.

(2) Applicant has not advanced nonobvious evidence that applicant's compound of formula (I) would combine with cyprodinil, pyrimethanil or any other methionine biosynthesis inhibitor to provide unexpectedly greater efficacy than compound of

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Example 5 and other structurally similar compounds disclosed by WO 01/11965 (which are readable on applicant's formula (I) compounds).

For these reasons, applicant's data is found insufficient and not commensurate in scope with that of the claimed subject matter. Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,776,892.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The patented claims are directed to a composition comprising the same compound (I) as in applicant's claim 8 + a compound capable of inhibiting spores of germination or mycelium growth by acting on different metabolic routes + cyprodinil (see all claims, claim 9 in particular). Method for controlling phytopathogenic fungi of crops by applying the composition to seed, plant, fruit of the plant or soil is disclosed (claim 12).

As the same combination of formula (I) + cyprodinil + another fungicide is disclosed, one having ordinary skill in the art would have recognized that the instant invention is an obvious variation of the invention set forth in the patented claims.

It is noted that the Examiner and applicant's attorneys, Mr. Grandinetti and Mr. James, discussed allowing the claims by limiting component (B) to cyprodinil. However, the double patenting issue was newly raised after a search update and a final agreement could not be timely reached. See Interview summary, attached hereto.

Applicant is **further advised** that a new 103 ground of rejection has been made in this Office action. As a result, any previous indication of allowability (allowable but for

the double patenting issue) must be rescinded because applicant must now address and overcome said new ground of rejection.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to John Pak whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/
Primary Examiner, Art Unit 1616